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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,533	07/24/2002	Luis Felipe Guglielmucci		8347
32529	7590	05/27/2004		
LUIS FELIPE GUGLIELMUCCI ENRIQUE BARRENECHEA 3820, MACUL SANTIAGO; CHILE				
			EXAMINER HARLE, JENNIFER I	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,533

Applicant(s)

GUGLIELMUCCI, LUIS FELIPE

Examiner

Jennifer I. Harle

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/24/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-2 are pending. Claims 1-2 are rejected.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the

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title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

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- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The examiner notes several issues, including the appearance that bold typeface has been utilized, the title is very lengthy, there is a related application (SN 10/064534), and the formatting of the claims is improper.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 2 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is not directed toward any process, machine, manufacture, or composition of matter. It is not clear what type of subject matter it is directed toward.

Claim Objections

Claims 1 and 2 are objected to because of the following informalities:

Each claim begins and ends with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. Where a claim sets for a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. MPEP 608.01(m).

The claims should start with "I claim," "The invention claims is," "What is claims is."

For example:

What is claimed is:

1. A method

MPEP 609.01(m).

It is unclear what applicant incorporates into customized whether it is fitting the customers reproducer device and acoustic profile or whether it is sales conditions and/or customer uses and/or customers preferences. The two sentences do not make them mutually exclusive as the wording states it could also involve and thus it may not have to fit the customer's reproducer device ...

It is unclear what is meant by the combination of the multiple sound tracks, video files and data files available in and original performing art record into customized group of sound, video and data files that this the customer's reproducer device, as only one of the type of files may be

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available for use in the reproducer device as shown in the proposed drawing i.e. sound, not video. .

The examiner is interpreting this to mean that applicant is claiming in the alternative with multiple tracks.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specially customization to fit the customer's reproducer device and acoustic profile of the producer's location and the involvement of sales conditions and/or customers uses and/or customers preferences in the customization and/or a media reproducing system with the acoustic characteristics of the speakers' environment determination functions. The application discloses that the business model requires access to Internet, storage capacity for music files, mutli-channel reproduction capability, complementary device's control capabilities, an application or embedded capabilities to determine: the customer's preferences regarding music and related media experience and the acoustic characteristic of user's environment [0009]. The application additionally discloses that the seller should have an application able to produce a CMRG (Customized Multi-channel Recording File) using the customer's profile and the original master record which will be transferred to the user's reproducing

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device through the Internet or other distribution channels and will be automatically created at the invented system considering: the customer's purchased option, the customer's reproducer system's characteristics in terms of available channels speakers available storage space, etc., the customer listens site acoustic characteristics [0014]. The application further discloses that the customer reproduction device could be supported in a PC or in a stand-alone device, however, in either case will support multiple attached speakers' control, environment's acoustic characteristics determination functions, multi-channel sound traces storage and reproduction, search and structured storage functions, reproduction's characteristics control, i.e. volume, reverberation, echo, tone, etc. [0016]. Then the application states that the commercial technology to support this invention needs to be created for the CMRFs on currently available hardware and software [0025], the business rules need to be created and supported on currently available commercial hardware and software [0026], the currently available audio and computer technology needs to be integrated to create these multi-channel storage and reproduction systems connected to these types of devices [0027], the acoustic print determination function must be incorporated into these devices [0027] and for active sound absorption devices technology must be developed [0028]. The specification concludes with that the current knowledge of the inventor there are only two audio reproducing technologies with any similarities with the ones required to support CMRFs but that none of these systems could function in the manner necessary [0035]. Thus, the hardware and software necessary to implement the invention according to applicant's own admissions did not exist at the time of the invention and thus, the claims are not enabled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Claesson, et al. (US 2002/0075965).

Claesson discloses a combination of multiple sound tracks, video files and data files available in an original performing art record ([0009]-[0013] and [0029]-[0115] – an original samples signal, relates to digital signal processing, and specifically audio – see discussion above under claim objection and can be used with video and data, i.e. television and the internet) into a customized group of sound, video and data files that fits the customer's reproducer device and acoustic profile of the reproducer's location to enrich the customer experience and meet the customers uses and/or customers preferences (a variety of digital signal processor configurations are enable which may be flexibly configured to enhance the clarity and intelligibility of digital audio – regardless of the encoding scheme employed, the delivery mechanism the nature of the listening environment, or the preferences of the listener, the digital signal processors of the invention may be configured to effect processing of the digital audio in a manner which enhances the listener's experience ... [0011], [0029]-[0115]), and the capability of allow multi-channel soundtracks storage and reproduction with or without on line support from the vendor's system ([0012], [0029]-[0115]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claesson, et al. (US 2002/0075965) in view of Hunter, et al. (2002/0111912).

Claesson discloses a method of transmitting to a customer a version of a performing art record of audio, video and/or data that has been derived from a master record (i.e. an original sampled signal) and specially customized to fit the customer's reproducer device and acoustic profile (i.e. included in the user's preferences in either the user's device or in) of the reproducer's location and/or customers uses and/or customers preferences ([0009]-0013] and [0029]-[0115]. However, Claesson does not specifically disclose that the method is utilized for selling the product to a customer. Hunter discloses that current music distribution methods have numerous failings including that affect pricing, customer satisfaction and the ability of music content providers to maximize revenue, including the ability to make all of their content, including older recordings readily available at market clearing pricing, permit customer ready access to thousands of recordings in a convenient low cost manner that fully satisfies user demand, while enhancing economic incentives of music content providers to create and distribute an ever expanding offering of music, prevent piracy of software, music and video materials causing economic losses to the originators and distributors through copyright violations ([0003]-[0014]. Hunter further teaches a method that is designed to distribute and maximize revenue of music libraries that customize the

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recordings for the customer device based upon a customer profile that takes into account sales conditions and/or customers uses and/or customers preferences and that protect against losses in profits from piracy, thereby increasing revenues to the providers and satisfaction to the consumers ([0015]-[0023]). Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized a sales method as taught in Hunter in the system of Claesson for the reasons set forth above, i.e. ensure that the revenue stream due to the copyright holders was maintained and that the customers were satisfied with the products.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-2 of copending Application No. 10/064,534. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are a process and an apparatus for its practice.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

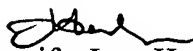
Sull, et al. (US 2002/0069218 A1) discloses a system and method for indexing, search, identifying and editing portions of electronic multimedia files.

Hurtado, et al. (6,611,821 B2) discloses secure electronic content distribution on CDs and DVDs derived from a master record and customized to fit on a customer's reproducer device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Ione Harle
May 20, 2004